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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>420-002</b>	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>March 24 2006</u></p> <p>Signature <u>[Signature]</u></p> <p>Typed or printed name <u>Tanya J. Mirilovich</u></p>		Application Number <b>09/684,032</b>	Filed <b>10/6/2000</b>
		First Named Inventor <b>Christopher S. Nolan</b>	
		Art Unit <b>3652</b>	Examiner <b>Charles A. Fox</b>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ attorney or agent of record. **41,713**  
Registration number \_\_\_\_\_
- ☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

[Signature]  
Signature  
**Andrew D. Dorisio**  
Typed or printed name  
**859/ 252-0889**  
Telephone number  
**3/22/06**  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Christopher S. Nolan

Serial No.: 09/684,032

Filed: October 6, 2000

For: **LINER FOR CONTAINER  
WITH SIDE DOOR**Examiner: Charles A. Fox  
Group Art Unit: 3652

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
**FILED CONCURRENTLY WITH NOTICE OF APPEAL**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed November 23, 2005, Applicant hereby reinstates his appeal of the Examiner's rejections. As required by MPEP §1204.01, Applicant files a new Notice of Appeal herewith. In view of the Pre-Appeal Brief Conference Pilot Program established in the Official Gazette of July 12, 2005 and indefinitely extended January 1, 2006, Applicant hereby requests a pre-appeal review of the present rejections.

Currently, claims 1-8 and 12-18 are pending and all stand rejected. Briefly summarizing the rejections, claims 1, 2, 5, and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,951,284 to Fell et al. (the "'284 Patent"). Claims 1, 2, 5, 6, 13, and 17 are rejected under 35 U.S.C. §103(a) as being obvious in view of the '284 Patent. The Examiner combines the '284 Patent with Applicant's U.S. Patent No. 5,028,197 to Krein et al. (the "'197 Patent") to reject claims 3, 4, 12, and 15 as being obvious. Similarly, claims 7 and 8 are rejected as being obvious in view of the '284 Patent combined with U.S. Patent No. 5,746,862 to Derby (the "'862 Patent"). Also, claims 14 and 18 are rejected as being obvious in view of the '284 Patent combined with U.S. Patent 4,516,906 to Krein (the "'906 Patent"). Finally, claim 16 is rejected as being obvious in view of the '284 Patent combined with U.S. Patent No. 3,456,834 to Paton (the "'834 Patent").

As herein discussed, the Examiner has failed to meet the burden necessary to reject any of the pending claims under 35 U.S.C. §102(b) or 35 U.S.C. §103(a). Accordingly, Applicant respectfully requests that the Panel reverse the rejections and allow all pending claims.

**I. CLAIMS 1, 2, 5, 6, 13, AND 17 ARE NOT ANTICIPATED BY THE '284 PATENT.**

With regard to the anticipation rejection, the '284 Patent fails to teach each and every limitation of claims 1, 2, 5, 6, 13, and 17. The Examiner expressly acknowledges this point, yet maintains his rejection under 35 U.S.C. §102(b). Most recently, on page 4 of the Office Action mailed November 23, 2005, the Examiner states, "... *Fell et al. do not explicitly teach the opening in the side of the liner.* ..." (emphasis added). Instead, it merely shows the conventional opening formed in the *end panel* of the liner. As claims 1, 2, 5, 6, 13, and 17 clearly require "an access opening along at least one *side panel*," Applicant is baffled by the Examiner's anticipation rejection. Since the Examiner has not shown with the requisite strict identity that each and every limitation of the claim is met (which is of course an unwavering requirement for maintaining an anticipation rejection), these claims are not anticipated.

**II. CLAIMS 1-8 AND 12-18 ARE NOT RENDERED OBVIOUS BY THE '284 PATENT TAKEN ALONE OR IN COMBINATION WITH OTHER PATENTS.**

**A. THE '284 PATENT TAKEN ALONE FAILS TO RENDER  
CLAIMS 1, 2, 5, 6, 13, AND 17 OBVIOUS**

Section 2143.01 of the Manual of Patent Examining Procedure provides that "[i]f the proposed modification . . . of the prior art would change the principle of operation of the prior art invention being modified, *then the teaching . . . [is] not sufficient to render the claims prima facie obvious.*" (emphasis added). In this instance, modifying the liner in the Examiner proposed manner would "change the principle of operation" of the "prior art invention" disclosed in the Fell et al. patent, which at col. 7, ll. 47-48 explains that "[o]nce the container has reached its destination *some means must be provided to tilt the container.*" (emphasis added). Moreover, this patent teaches that "... as the container empties it is tipped to allow the bulk material to flow down *towards the unloading end of the liner*" (col. 8, ll. 4-6, emphasis added).

Clearly, the inventors only contemplated having an opening in the *end* of the liner, *not in the side panel* of the liner as required by claims 1, 13, and 17. Furthermore, modifying the liner as proposed would not allow for the desired "flow" of materials discussed in the '284 Patent as being

an advantage of the invention. Even if a corresponding container, such as a rail car, was capable of tilting on its side, the contents of the container would not flow to the unloading *end* of the liner. Instead, only a portion of the contents would exit the side opening of the container, while the remainder would be pressed against the side wall of the container. Since the proposed liner modification would dramatically change the operation of “prior art invention” disclosed in the Fell et al. patent, the *prima facie* case of obviousness is lacking<sup>1</sup>.

During prosecution, the only passage cited by the Examiner as allegedly suggesting the proposed modification merely states that “. . .there is provided a device for transporting bulk material in a shipping vehicle *having walls, one of which defines a door opening* and doors attached thereto. . .” ‘284 Patent, Col. 2, ll. 25-28 (emphasis added). Rather than suggesting that “the door to the container can be in any of the walls to the container,” this passage merely states that one of the *walls* defines a *door opening*. To stretch this passage as proposed would *require* the entire elongated side wall of the container “define” a door opening. Not only would this result in a structurally unsound container, but it would render the Fell et al. patent inoperable. In particular, if the entire side wall defines the door of the container, portions of the liner would simply fall out of the container when it is tilted, as *must* be done for emptying the contents of the container according to the Fell et al. patent. Clearly, this is not the end result desired by this patent, which teachings must be construed in *pari materia* rather than in the piecemeal approach taken by the Examiner. See M.P.E.P. Section 2141.03 (“*A prior art reference must be considered in its entirety*, i.e., as a whole, including portions that would lead away from the claimed invention.”) (emphasis added).

Accordingly, the Examiner has failed to establish a *prima facie* case of obvious in view of the ‘284 Patent taken alone.

#### **B. THE ‘284 PATENT IN COMBINATION WITH THE ‘197 PATENT FAILS TO RENDER CLAIMS 3, 4, 12, AND 15 OBVIOUS**

With regard to these claims, the Examiner fails to identify where the ‘284 and ‘197 Patents teach or suggest each and every limitation. See Manual of Patent Examining Procedure § 2143.03 (stating that “[t]o establish *prima facie* obviousness of a claimed invention, *all claim limitations must be taught or suggested by the prior art*”) (emphasis added) (citations omitted).

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<sup>1</sup> For further discussion supporting that these claims are not rendered obvious, see Applicant’s Response filed March 11, 2004.

With regard to claims 3 and 4 the Examiner admits that the '284 Patent fails to "teach the liner and tubes as being a plastic sheet material joined by heat welding of the mating surfaces." However, the '197 Patent also fails to supply this teaching, and the record otherwise lacks any objective evidence of it. The '197 Patent *never* makes direct reference or allusion to a liner with "an access opening along at least one side panel" nor a liner and "open tube" formed of plastic sheet and a heat seal bead.

Similarly, with regard to claim 12, the '197 Patent *never* mentions use of an air source in conjunction with a liner with "an access opening along at least one side panel." As for claim 15, the Examiner provides absolutely no support for his assertion of obviousness. This is likely because neither patent comes close to teaching the limitations of this claim.

In view of these deficiencies in the Examiner's rejections and the teachings of these patents, no *prima facie* case of obviousness has been established.

#### **C. THE '284 PATENT IN COMBINATION WITH THE '862 PATENT FAILS TO RENDER CLAIMS 7 AND 8 OBVIOUS**

Similarly, with regard to claims 7 and 8, the Examiner again fails to identify where the '284 and '862 Patents teach or suggest each and every limitation of these claims. Claim 7 clearly requires that "the side panels include folds to allow expansion." Nowhere does the '862 Patent show side panels including folds to allow expansion, nor does the Examiner make an assertion to the contrary. Instead, the Examiner identifies the "opposing horizontal gussets 22 and 24," as constituting these folds. Even if one were to construe the gussets 22 and 24 as the folds in Applicant's claim 7, they are not in the *side panels*! The '862 Patent only shows gussets in the end panels.

Moreover, claim 8 further requires that the end panels are formed by "folded end sections" of the side panels and a heat seal bead extending across the folds. The Examiner's rejection simply does not provide the necessary evidence to support a *prima facie* case of obviousness, since each and every limitation required is not found in the combination of the '284 and '862 Patents, or in any other objective evidence relied upon by the Examiner.

#### **D. THE '284 PATENT IN COMBINATION WITH THE '906 PATENT FAILS TO RENDER CLAIMS 14 AND 18 OBVIOUS**

The '284 Patent goes to great lengths to discuss an elaborate connector system to retain the liner. In contrast, the '906 Patent teaches a liner that does not require an elaborate connector system.

The author of the '906 Patent agrees with this assertion, as he or she disparages the '284 Patent in the "Description of Prior Art" ('906 Patent, Col. 1, ll. 35-40).

The Federal Circuit has held that "[e]lements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis added). There is clearly no suggestion of the proposed combination anywhere in the '284 or '906 Patent. Indeed, the '906 Patent teaches away from such a combination. Accordingly, the cited combination of patents is improper and fails to establish a case of *prima facie* obviousness.

**E. THE '284 PATENT IN COMBINATION WITH THE '834 PATENT  
FAILS TO RENDER CLAIM 16 OBVIOUS**

Claim 16 requires "a manifold including a plurality of orifices for enabling installation of the liner via air pressure." In the November 23, 2005 Office Action, the Examiner never identifies where either the '284 or '834 Patent teach this limitation. Instead, he makes several irrelevant and unsubstantiated allegations regarding these patents (See Nov. 23 Action, p. 6). Since neither the '284 nor the '834 Patent teach or suggest the "manifold" of claim 16, and the Examiner has failed to even make an attempt at establishing a case of *prima facie* obviousness, this claim should be allowed.

**III. CONCLUSION**

Accordingly, Applicant submits all claims are in a condition for allowance and requests a decision indicating same. The undersigned hereby authorizes the deduction of any necessary fees from Deposit Account No. 11-0978.

Respectfully submitted,

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being sent by First Class Mail in an envelope addressed to Mail Stop AF, Commissioner for Patents,  
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Date March 22, 2006

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